

Serial No. 10/709,824  
Attorney Docket No. 60655.8500

### **REMARKS**

Applicants reply to the Office Action mailed on November 28, 2005, within the shortened statutory period for reply. Claims 1-10 were pending and the Examiner rejects claims 1-10. In reply, Applicants amend claims 1-4 and 6-7, add claims 11-13, and address the Examiner's remarks. Support for the amendments may be found in the originally-filed specification, claims, and figures. No new matter has been introduced by these amendments. Reconsideration of this application is respectfully requested.

### **Double Patenting**

The Examiner provisionally rejects claim 1 over claim 1 of co-pending Application Serial No. 10/708,823. While Applicants respectfully disagree with this double patenting rejection, in the interest of compact prosecution, Applicants submit a terminal disclaimer, without prejudice, in compliance with 37 C.F.R. § 1.321(c). Applicants also assert that this provisional non-statutory double patenting rejection is based on the above-listed application, which is commonly owned with this application by assignee, American Express Travel Related Services Company, Inc.

### **Claim Rejections**

#### **§112 Rejections**

Claims 1-10 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Serial No. 10/709,824  
Attorney Docket No. 60655.8500

Regarding use of the term "detecting a proffered biometric" in claim 1, Applicants amend claim 1 to clarify that it is a "biometric sample" that is detected by a biometric sensor. This amendment is supported in the specification in at least paragraphs [00231]-[00233].

Applicants amend claims 3 and 6 to remove the redundant terms "detecting" and "detection." Applicants amend claim 4 to clarify that the detecting may include "receiving a limited number" of biometric samples.

Regarding claim 5, Applicants assert that "detecting includes logging each proffered biometric sample" would be understood in the art to mean that the system logs or maintains a record of each proffered biometric sample. Thus, Applicants believe that no further amendment is necessary.

Accordingly, Applicants request withdrawal of the rejection of claims 1-9 under 35 U.S.C. §112.

#### §102 Rejections

Claims 1-10 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Pat. No. 6,703,918 (Kita). Applicants respectfully traverse.

While Kita may disclose a portable information device with biometric security measures, the Kita reference does not teach or suggest a biometric security method comprising at least "determining whether said biometric sample is associated with a preset transaction limitation," as recited in independent claim 1. (emphasis added). Support for this amendment is found in the specification in at least paragraphs [00235-00238].

Accordingly, Applicants assert that claim 1 is patentable over the cited reference. Claims 2-10 variously depend from claim 1 and contain all of the elements thereof. Therefore,

Serial No. 10/709,824  
Attorney Docket No. 60655.8500

Applicants respectfully submit that claims 2-10 are differentiated from the cited reference at least for the same reasons as set forth above, in addition to their own respective features. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1-10.

#### New Claims

New claims 11-13 variously depend from claim 1 and contain all of the elements thereof. Therefore, Applicants assert that new claims 11-13 are differentiated from the cited references at least for the same reasons as set forth above, in addition to their own respective features.

#### CONCLUSION

Applicants respectfully submit that the pending claims (13 total, 1 independent) are in condition for allowance. No new matter is added in this Reply. Reconsideration of the application is thus requested. The Commissioner is hereby authorized to charge any fees that may be required, or credit any overpayment, to Deposit Account No. 19-2814. Applicants invite the Examiner to telephone the undersigned if the Examiner has any questions regarding this Reply or the application in general.

Respectfully submitted,

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